

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. SAULPAUGH,
GREGORY L. SLAUGHTER, MOHAMED M. ABDELAZIZ
and
BERNARD A. TRAVERSAT

Application 09/653,215

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on February 26, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that on page 2 of the Final Rejection mailed April 4, 2006, claims 8, 24, and 40 were listed under the heading "Allowable Subject Matter." However, the Examiner's Answer mailed December 4, 2006 included claim 24 in the § 102(a) rejection appearing on page 3 (Claims 1, 2, 5, 6, 9-18, 21, 22, 24-34, 37, 38, and 41-47 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Adams U.S. Pat. No. 6718470 (hereinafter Adams)). It appears that the inclusion of claim 24 listed above creates a new ground of rejection.

37 CFR § 41.39 (2005) states:

§ 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant

must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See

§ 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters

in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed December 4, 2006. Once the Examiner's Answer mailed December 4, 2006 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new ground of rejection;
- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new ground of rejection.

In addition, page 9 of the Final Rejection mailed April 4, 2006, includes claims 17-23, 25-39, and 41-47 in a 103(a) rejection as being unpatentable over Adams in view of Czerwinski. However, the Examiner's Answer mailed December 4, 2006 only lists the following § 103 rejections:

Claims 3, 7, 19, 23, 35, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams [page 8]; and

Claims 4, 20, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Czerwinski et al. "An Architecture for a Secure Service Discovery Service" (hereinafter Czerwinski) [page 9].

Clarification is required regarding the status of claims 17-23, 25-39, and 41-47 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski.

Accordingly, it is

ORDERED that the application is returned to the examiner:

1) to vacate the Examiner's Answer mailed December 4, 2006;

2) to select one of the following options:

a) reopen prosecution;

b) write a new Examiner's Answer without the new ground of rejection; or

c) write a new Examiner's Answer properly setting forth the new ground of rejection;

3) for clarification regarding the status of claims 17-23, 25-39, and 41-47 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski; and

4) for such further action as may be appropriate.

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